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CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 2 3 2004

In re application of:

Response Under 37 CFR § 1.116
Expedited Procedure

Ramos et al.

Art Unit 2174

OFFICIAL

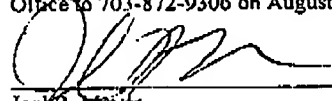Application No.: 09/636,102

Filed: August 10, 2000

Examiner: T. Vu

For: WATERMARK ENCODER AND
DECODER ENABLED SOFTWARE
AND DEVICES

Date: August 23, 2004

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Joel R. Meyer
Attorney for Applicant

APPEAL BRIEF

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Sir:

This brief is in furtherance of the Notice of Appeal filed April 21, 2004. Please charge
the fee required under 37 CFR 1.17(f) or any deficiency thereof to deposit account 50-1071 (see
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I   REAL PARTY IN INTEREST

The real party in interest is Digimarc Corporation, by an assignment from the inventors recorded at Reel 011427, Frames 0012-0013, on January 2, 2001.

II   RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III.   STATUS OF CLAIMS

Claims 2, 5-7 and 9-20 stand finally rejected and appealed.

IV.   STATUS OF AMENDMENTS

Applicants amendment after the final rejection has been entered. This amendment canceled claims 1, 3-4, and 8, and re-wrote claims 2, 5, 7 and 9 in independent form.

V.   SUMMARY OF THE INVENTION

Claim 2 recites a file browser system. This system comprises a file browser for displaying in a user interface a representation of media object files stored in memory. It also comprises a file browser extension for decoding an object identifier from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the object identifier. The object identifier is decoded from a watermark embedded in the selected media object file. See, for example, specification at pages 5-13 and accompanying Figs. 1-3. For an explanation of watermarks, please see page 1, line 22, to page 2, line 5 of the specification.

Claim 5 recites a variant of the file browser system. This system has a file browser and file browser extension like claim 2, but it does not specifically recite decoding the object identifier from a watermark. The file browser extension forwards the object identifier to a metadata server, and displays metadata or an action returned from the server. See, for example, page 6, line 14, to page 7, line 3.

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Claim 7 is another variant of the file browser system in which the metadata or action is displayed as a URL link to information or a program associated with the selected media object file. See, for example, page 6, lines 16-20.

Claim 9 recites yet another file browser system. It comprises a file browser and a file browser extension for encoding an object identifier into a selected media object file and for displaying in an extension of the user interface one or more options for enabling a user to enter input to control the encoding of the object identifier. The file browser extension comprises a watermark encoder for encoding the object identifier into the selected media object file. See, for example, page 30, line 21 to page 31, line 21, and Figs. 1 and 6.

Claim 10 recites a watermark decoder system comprising a host application having a user interface for displaying a representation of media object files, and an extension to the host application for decoding a watermark from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the watermark.

Claim 11 recites an internet browser on a computer readable medium. The browser comprises a listener program for identifying a media object in an HTML document, and for inserting a handler into the HTML document when an object identifier is extracted from the media object. The handler is operable to display metadata linked via the object identifier in response to user input. See, for example, page 12, line 8 to page 13, line 6.

Claim 14 recites a method of rendering a media object comprising decoding an object identifier from the media object, sending the object identifier to a metadata server, receiving a brand identifier from the metadata server; and displaying a representation of the brand identifier. See, for example, page 17, line 17 to page 18, line 27.

Claim 19 recites a method for extending a user interface of a media player. In response to input requesting playback of a media object, the method extracts an object identifier from the media object. It uses the object identifier to look up metadata associated with the media object and extends a user interface of a media player to include a representation of the metadata associated with the media object. See, for example, page 23, line 5 to page 24 line 27 and Fig. 5.

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VI. ISSUES

- Did the Office err in rejecting claims 2, 5-7, 9 and 14-20 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,606,609 to Houser et al. (Houser)?

- Did the Office establish a prima facie case of obviousness in rejecting pending claims 11-13 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,801,689 to Huntsman ("Huntsman") in view of Houser when: when (a) the references – collectively – fail to detail all of the elements claimed, and (b) there is no teaching or suggestion in the art that would have led an artisan to modify and combine the references as proposed?

VII. GROUPING OF CLAIMS

Claims 2, 5-7, 9 and 14-20 are independently patentable.

VIII. ARGUMENT

The cited references fail to teach all of the elements of the claims as set forth below. In addition, the references lack the requisite motivation or suggestion to combine and modify their teachings to produce the invention as claimed.

Claim 2

Claim 2 reads as follows:

2. A file browser system comprising:

a file browser for displaying in a user interface a representation of media object files stored in memory; and

a file browser extension for decoding an object identifier from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the object identifier; wherein the object identifier is decoded from a watermark embedded in the selected media object file.

Houser does not disclose how to decode an object identifier from a watermark embedded in a selected media object file, in combination with the other elements of the claim. Houser

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mentions a "watermark generator" that generates an "electronic watermark", but fails to describe decoding an object identifier from a watermark embedded in a selected media object file as claimed. Houser is completely silent as to any method for decoding an object identifier from a watermark created by the "watermark generator." Houser's watermark is designed to provide some form of visual indicia that is displayed or printed (e.g., "a difficult to forge image or icon", See Houser at col. 16, line 61), and Houser fails to describe any method for decoding an object identifier from this visual indicia.

In the Advisory Action in response to Applicant's amendment after final, the Examiner appears to no longer rely on the reference to a watermark generator in Houser at col. 16, lines 52-67 (See rejection of claim 2 at page 2 of the Final Rejection). Instead, the Examiner now relies on a different portion of Houser as allegedly teaching that "the object identifier is decoded from a watermark embedded in the selected media object file". In particular, the Examiner "considers a watermark as a security object being embedded in an electronic document see col. 7, lines 30-43." See Advisory Action at paragraph 1 citing col. 7, lines 30-43 as teaching the claimed watermark. Houser never teaches that the security object is a watermark as defined in Applicants' specification. Namely, a watermark is a machine readable code that is embedded in media by modifying the media. See Applicants' specification at page 1, lines 22-25.

Moreover, Houser does not teach any method of decoding an identifier from a watermark that is embedded in a media object file as claimed.

Claim 5

Claim 5 reads as follows:

5. A file browser system comprising:

a file browser for displaying in a user interface a representation of media object files stored in memory; and

a file browser extension for decoding an object identifier from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the object identifier, wherein the file browser extension forwards the object identifier to a metadata server, and displays metadata or an action returned from the server.

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Houser fails to disclose the claimed metadata server or its interaction with other elements of the claim, such as a metadata server that returns metadata or an action as claimed. In the Final Rejection, the Examiner cited element 140 of Fig. 1, which merely corresponds to text at col. 8, lines 34-39 relating to storing or forwarding documents. The Examiner also cited col. 15, lines 25-35, which is silent regarding forwarding an object identifier to a metadata server and displaying metadata or an action returned from the server. Now, in the Advisory Action in response to Applicants' amendment after final, the Examiner has cited Fig. 1, col. 9, lines 55-60, col. 8, lines 58-65, and col. 12, lines 55-67. These citations fail to teach the claimed metadata server and the interaction between the metadata server and the file browser extension as claimed.

Claim 6

Claim 6 reads as follows:

6. *The file browser system of claim 5 wherein the file browser extension extracts and displays metadata from the media object file along with metadata returned from the metadata server.*

Houser fails to teach a file browser extension as claimed that extracts and displays metadata from the media object file along with metadata returned from the metadata server.

Claim 7

Claim 7 reads as follows:

7. *A file browser system comprising:*

a file browser for displaying in a user interface a representation of media object files stored in memory; and

a file browser extension for decoding an object identifier from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the object identifier; wherein the metadata or action is displayed as a URL link to information or a program associated with the selected media object file.

Houser fails to disclose: "the metadata or action is displayed as a URL link to information or a program associated with the selected media object file" in combination with the other elements of the claim.

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Claim 9

Claim 9 reads as follows:

9. A file browser system comprising:

a file browser for displaying in a user interface media object files stored in memory; and

a file browser extension for encoding an object identifier into a selected media object file and for displaying in an extension of the user interface one or more options for enabling a user to enter input to control the encoding of the object identifier; wherein the file browser extension comprises a watermark encoder for encoding the object identifier into the selected media object file.

Houser fails to disclose a watermark encoder for encoding the object identifier into the selected media object file in combination with the other claim elements. Houser's watermark is designed to provide some form of visual indicia that is displayed or printed (e.g., "a difficult to forge image or icon", See Houser at col. 16, line 61), and Houser fails to describe any method for encoding an object identifier with a watermark encoder as claimed. Moreover, Houser fails to teach a user interface for enabling a user to enter input to control the encoding of the object identifier as claimed.

Claim 10

Claim 10 reads as follows:

10. A watermark decoder system comprising:

a host application having a user interface for displaying a representation of media object files; and

an extension to the host application for decoding a watermark from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the watermark.

Houser fails to disclose decoding a watermark and displaying in an extension of the user interface metadata or an action associated with the media object file via the watermark. Houser refers to generating visual indicia called in "electronic watermark," but fails to describe decoding a watermark and associating metadata or an action with a media object file via the watermark.

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Claim 11

Claim 11 reads as follows:

11. An internet browser on a computer readable medium, the browser comprising:

a listener program for identifying a media object in an HTML document; and for inserting a handler into the HTML document when an object identifier is extracted from the media object;

wherein the handler is operable to display metadata linked via the object identifier in response to user input.

Houser and Huntsman fail to disclose or suggest inserting a handler into a document as claimed, where the handler is operable to display metadata linked via the object identifier in response to user input in combination with the other claim elements. Though not entirely clear, it appears that the Examiner previously took the position in the Final Rejection that Houser's electronic watermark corresponds to the claimed "handler". However, Houser's electronic watermark is not "operable to display metadata linked via the object identifier in response to user input" as claimed. Huntsman does not disclose or teach this aspect of the claim either, and therefore, the cited art does not render claim 11 or its dependent claims obvious.

The Examiner's remarks in the Advisory Action do not refer to the electronic watermark in Houser, but instead, refer to various other passages, such as: col. 7, lines 30-43, col. 19, lines 17-26, col. 4, lines 3-10, col. 13, lines 35-50 and col. 15, lines 62-67. To the extent understood, it appears that the Examiner is referring to Houser's extraction of a security object from a document. Houser's extraction process does not involve "inserting a handler into the HTML document when an object identifier is extracted from the media object" as claimed. The combined teachings of the cited art fail to teach all of the elements of the claims, and there is no motivation to modify these teachings to arrive at the claimed combination of elements of claim 11.

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Claim 12

Claim 12 reads as follows:

12. The internet browser of claim 11 wherein the object identifier is decoded from a watermark embedded in the media object.

Houser and Huntsman fail to teach: "the object identifier is decoded from a watermark embedded in the media object." As stated previously, Houser does not teach decoding an object identifier from a watermark embedding in a media object as claimed. Huntsman does not provide this teaching either.

Claim 13

Claim 13 reads as follows:

13. The internet browser of claim 11 wherein the metadata is retrieved from a metadata server by sending the object identifier to the metadata server.

Houser and Huntsman fail to teach or suggest "the metadata is retrieved from a metadata server by sending the object identifier to the metadata server" as claimed. The Examiner relies on Fig. 1 element 140 as allegedly teaching the claimed metadata server. However, as noted above in connection with claim 5, this part of Houser's system is unrelated to the claimed metadata server.

Claim 14

Claim 14 reads as follows:

14. A method of rendering a media object comprising:
decoding an object identifier from the media object;
sending the object identifier to a metadata server;
receiving a brand identifier from the metadata server; and
displaying a representation of the brand identifier.

Houser fails to disclose the claimed interaction with a metadata server, brand identifier, and representation of brand identifier. The Examiner has cited additional passages of Houser to support his position in the Advisory Action, yet none of these passages relate to the claimed processing of a brand identifier.

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Claim 15

Claim 15 reads as follows:

15. The method of claim 14 wherein the object identifier is decoded from a watermark embedded in the media object.

Houser fails to teach an object identifier is decoded from a watermark embedded in the media object.

Claim 16

Claim 16 reads as follows:

16. The method of claim 14 wherein the media object is a video or an image, and the representation of the brand identifier is a graphic superimposed on a rendering of the video or image.

Houser fails to teach a media object is a video or an image, and the representation of the brand identifier is a graphic superimposed on a rendering of the video or image.

Claim 17

Claim 17 reads as follows:

17. The method of claim 16 wherein the graphic is a hot link to information or an action associated with the media object.

Houser fails to teach a media object is a video or an image, and the representation of the brand identifier is a graphic superimposed on a rendering of the video or image.

Claim 18

Claim 18 reads as follows:

18. The method of claim 17 wherein selecting the hot link causes retrieval of the information or action from a remote server.

Houser fails to teach selecting the hot link causes retrieval of the information or action from a remote server.

Claim 19

Claim 19 reads as follows:

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19. A method for extending a user interface of a media player comprising:

in response to input requesting playback of a media object, extracting an object identifier from the media object;

using the object identifier to look up metadata associated with the media object;

extending a user interface of a media player to include a representation of the metadata associated with the media object.

Houser fails to teach elements of claim 19, such as "extending a user interface of a media player to include a representation of the metadata associated with the media object" along with the claimed process for extracting an object identifier from the media object and using it to look up the metadata.

Claim 20

Claim 20 reads as follows:

20. The method of claim 19 wherein extracting the object identifier includes decoding the object identifier from a watermark embedded in the media object.

Houser fails to teach "decoding the object identifier from a watermark embedded in the media object" as claimed.

IX. CONCLUSION

For the foregoing reasons, the final rejection of the claims should be reversed.

Date: August 23, 2004

Respectfully submitted,

DIGIMARC CORPORATION

Customer Number 23735

Telephone: 503-885-9699
FAX: 503-885-9880

By _____
Joel R. Meyer
Registration No. 37,677

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APPENDIX

2. A file browser system comprising:

a file browser for displaying in a user interface a representation of media object files stored in memory; and

a file browser extension for decoding an object identifier from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the object identifier; wherein the object identifier is decoded from a watermark embedded in the selected media object file.

5. A file browser system comprising:

a file browser for displaying in a user interface a representation of media object files stored in memory; and

a file browser extension for decoding an object identifier from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the object identifier, wherein the file browser extension forwards the object identifier to a metadata server, and displays metadata or an action returned from the server.

6. The file browser system of claim 5 wherein the file browser extension extracts and displays metadata from the media object file along with metadata returned from the metadata server.

7. A file browser system comprising:

a file browser for displaying in a user interface a representation of media object files stored in memory; and

a file browser extension for decoding an object identifier from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the object identifier; wherein the metadata or action is displayed as a URL link to information or a program associated with the selected media object file.

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9. A file browser system comprising:

a file browser for displaying in a user interface media object files stored in memory; and

a file browser extension for encoding an object identifier into a selected media object file and for displaying in an extension of the user interface one or more options for enabling a user to enter input to control the encoding of the object identifier; wherein the file browser extension comprises a watermark encoder for encoding the object identifier into the selected media object file.

10. A watermark decoder system comprising:

a host application having a user interface for displaying a representation of media object files; and

an extension to the host application for decoding a watermark from a selected media object file and for displaying in an extension of the user interface metadata or an action associated with the media object file via the watermark.

11. An internet browser on a computer readable medium, the browser comprising:

a listener program for identifying a media object in an HTML document; and for inserting a handler into the HTML document when an object identifier is extracted from the media object;

wherein the handler is operable to display metadata linked via the object identifier in response to user input.

12. The internet browser of claim 11 wherein the object identifier is decoded from a watermark embedded in the media object.

13. The internet browser of claim 11 wherein the metadata is retrieved from a metadata server by sending the object identifier to the metadata server.

14. A method of rendering a media object comprising:

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    decoding an object identifier from the media object;

    sending the object identifier to a metadata server;

    receiving a brand identifier from the metadata server; and

    displaying a representation of the brand identifier.

    15. The method of claim 14 wherein the object identifier is decoded from a watermark embedded in the media object.

    16. The method of claim 14 wherein the media object is a video or an image, and the representation of the brand identifier is a graphic superimposed on a rendering of the video or image.

    17. The method of claim 16 wherein the graphic is a hot link to information or an action associated with the media object.

    18. The method of claim 17 wherein selecting the hot link causes retrieval of the information or action from a remote server.

    19. A method for extending a user interface of a media player comprising:

    in response to input requesting playback of a media object, extracting an object identifier from the media object;

    using the object identifier to look up metadata associated with the media object;

    extending a user interface of a media player to include a representation of the metadata associated with the media object.

    20. The method of claim 19 wherein extracting the object identifier includes decoding the object identifier from a watermark embedded in the media object.

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